

Applicants: Volpe et al.
Application No.: 09/844,057

REMARKS/ARGUMENTS

After the foregoing amendments, claims 2-11, 13-19, 21, 22 and 24-28 are pending. Claims 10, 13, 15, 21, and 25-28 have been amended. Applicants submit that no new matter has been introduced by these amendments.

Claim Objections

Claim 26 was objected to because it contained a period within the claim. Claim 26 has been amended. Withdrawal of this claim objection is respectfully requested.

Claim Rejections - 35 USC § 102(e)

Claims 25-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gorbet (U.S. Pat. No. 6,072,480). While not specifically stated, it appears that claims 2, 3, 5-9, 11, 15-17, 21, and 22 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gorbet.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1379 (Fed. Cir. 2003) (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)); see also MPEP § 2131.

Independent claims 25-28 have been amended and are similar to claims 1, 12, 20, and 23 presented in Applicants' August 3, 2005 Reply. Amended claims 25-28

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claim "client selected, event related" materials arranged with a DJ performance. The September 19, 2005 Office Action acknowledges that Gorbet does not disclose the use of "client related materials." Therefore, Gorbet cannot anticipate amended claims 25-28. Schering Corp., 339 F.3d at 1379.

Namely, amended claim 25 claims "a collection of client selected, event related materials . . . fixed on the recording media." "Gorbet doesn't explicitly disclose a collection of client related material fixed on the media." See September 19, 2005 Office Action, page 3. Amended claim 26 claims "gathering client selected, event related materials . . . related to a future event." "Gorbet does not explicitly disclose gathering client related material associated with the future event." Id. at page 5. Amended claim 27 claims "means for gathering client selected, event related materials" and amended claim 28 claims "a selection of client selected, event related materials". "Gorbet does not explicitly disclose gathering client related material associated with the future event." Id. Based on the foregoing, Gorbet does not anticipate each and every element of the claimed invention of independent claims 25-28. See Schering Corp., supra. As such, Applicants respectfully submit that independent claims 25-28 are allowable. Because independent claims 25-28 are allowable, claims 2-11, 13-19, 21, 22 and 24 which depend therefrom, are also allowable.

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Claim Rejections - 35 USC § 103(a)

Claims 10, 13, 14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorbet.

Claims 25-28 are allowable for the reasons stated above and therefore, dependent claims 10, 13, 14 and 19 are allowable. Claims 10, 13, 14 and 19 are allowable for the following, additional reasons.

Claims 10, 13 and 14

In rejecting claims 10, 13 and 14, the Action found that Gorbet does not disclose "guest information" but that this feature is "well known" or in the case of claim 14 "inherent". The Action attempts to support this assertion with cites from pages from the website www.wikipedia.com ("wikipedia") that were attached to the Action. Since it is unclear whether claims 10, 13 and 14 are being rejected as obvious by the combination of Gorbet and wikipedia (see rejection of claim 19 on page 15) or by Gorbet only. This is necessary and the natural consequence of the Action because there is no evidence in the record indicating that wikipedia is prior art to the present application. MPEP § 706.02(j) ("It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply"); MPEP § 706.02(a); MPEP § 707.05(e).

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MPEP § 2144.03 provides that “[i]n limited circumstances, it is appropriate for an examiner to . . . rely on ‘common knowledge’ in making a rejection, however such rejections should be judiciously applied.” MPEP § 2144.03. If official notice is taken, it must be readily supportable by documentary evidence capable of demonstrating instantly and unquestionably that the information is in fact, well-known in the art. Id.

The wikipedia reference does not instantly and unquestionably demonstrate that “guest information”, as that phrase is used in the present application, was well-known in the art. Nowhere in wikipedia is there any reference to the phrase “guest information.” In fact, the majority of wikipedia is devoted to the history and “Cultural Effects” of PowerPoint. The one section of wikipedia regarding the operation of PowerPoint does not discuss the content of a presentation or individual slides being “geared toward” the audience. Wikipedia includes one reference to PowerPoint being widely used by “educators,” but it is devoid of any reference to the example provided by the Examiner of an English professor creating or presenting a presentation for students relating to Shakespeare. Wikipedia does not “instantly” and “unquestionably” demonstrate that “guest information” was well-known in the art. Applicants respectfully traverse this finding and respectfully request the required documentary evidence to support the Examiner’s conclusions. See MPEP § 2144.03, Part C.

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Even assuming *arguendo* that wikipedia supports the Examiner's contentions, the claims are not rendered obvious because the guest information of the present invention is not disclosed or suggested by a PowerPoint presentation.

Claim 19

With respect to claim 19, the Action states that "the combination of Gorbet in view of RWM fails to disclose accepting a security deposit from the event client prior to the step of providing." However, the Examiner took "official notice" that taking a security deposit is notoriously well known in the art.

The rejection is unclear because, as stated on page 13 of the Action, claim 19 was rejected under 35 USC § 103(a) based on Gorbet only. Further, as presented in the August 3, 2005 Reply, RWM is not prior art to the present application and therefore, cannot be used in combination with Gorbet to render the claims of the present invention obvious. Applicants acknowledge that deposits may be a part of general, conventional practice, but would not render it obvious to one of ordinary skill in the art, at the time of the present invention. This is supported by the fact that none of the "references" cited thus far, disclose this feature, including wikipedia. Applicants respectfully request that the Examiner provide the required documentary evidence of the officially noticed fact. See MPEP § 2144.03, Part C.

Finally, Gorbet cannot render claim 10, 13, 14 and 19 obvious. Claims 10, 13, 14 and 19 depend from claims 25 and 26, respectively, which claim "client selected,

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event related materials". Gorbet does not explicitly disclose a collection of client selected, event related material fixed on the media (see Sept. 19, 2005 Action, page 3), nor is there any suggestion in the Action that this feature is obvious in light of Gorbet. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art") (emphasis added). For the foregoing reasons, Applicant's respectfully submit that claims 10, 13 and 14 are allowable.

Claims 4, 18 and 24

Claims 4, 18 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorbet in view of Bakos (U.S. Pat. No. 6,511,728). According to the Action, Gorbet does not disclose that the media has a predetermined life span; however, Bakos discloses an optical media that can only be used for a limited period of time and it would have been obvious to one of ordinary skill in the art to record the slide show of Gorbet onto a CD with a limited life.

Because claims 25, 26 and 28 are allowable for the reasons stated above, dependent claims 4, 18 and 24 are allowable. In addition, Gorbet does not disclose the use of a media capable of storing music or video but discloses only a general "CD ROM" (see col. 4, lines 57-61). Finally, claims 4, 18 and 24 depend from claims 25, 26 and 28, respectively which claim "client selected, event related materials".

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Gorbet does not explicitly disclose a collection of client related material fixed on the media (see Sept. 19, 2005 Action, page 3), nor is there any suggestion in the Action that this feature is obvious. See In re Royka, 490 F.2d 981; MPEP § 2143.03. There is no record basis for the combination of Gorbet and Bakos except the present application, and the rejection cannot stand to render claims 4, 18 and 24 obvious.

For the foregoing reasons, Applicant's respectfully submit that claims 4, 18 and 24 are allowable.

Conclusion

Applicants respectfully request reconsideration and further examination of the application based on the above-referenced amendments and arguments. If the Examiner believes that an interview will advance prosecution of this application, the Examiner is invited to contact the undersigned to arrange an interview at the Examiner's convenience.

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In view of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims, following this amendment, are in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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